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To: MAIL STOP APPEAL BRIEF PATENTS
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From: George M. Macdonald

Date: March 23, 2004

Subject: Serial No.: 09/683,381

Pages: 17 (including this cover)

OFFICIAL

Re: U.S. Patent Application Serial No.: 09/683,381
Our Docket # F-442
Conf. # 7716

In furtherance of the January 23, 2004 Notice of Appeal in the above referenced case, enclosed please find the Appellants' Brief.

CERTIFICATION OF FACSIMILE TRANSMISSION

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1. Appellants' Brief on Appeal (16 pages).

on March 23, 2004
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George M. Macdonald
Name of Registered Rep.
Reg. No.: 39,284March 23, 2004
Date

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Attorney Docket No.: F-442

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

OFFICIAL

In re patent application of:

) Attorney Docket No.: F-442

) Customer No. 919

Robert A. Cordery, et al.

)

Serial No.: 09/683,381

) Examiner: Richard Sukyoon Woo

Filed: December 19, 2001

) Group Art Unit: 3629

Confirmation No.: 7716

)

) Date: March 23, 2004

Title: **METHOD AND SYSTEM FOR NOTIFYING MAIL USERS OF MAIL
PIECE CONTAMINATION**

Mail Stop Appeal Brief- Patents
Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 1-17 of the above-identified application mailed October 23, 2003. Claims 1-17 stand at least twice rejected. This Brief is in furtherance of the Notice of Appeal filed in this case on January 23, 2004. This Brief is transmitted in triplicate. Accordingly, this brief is timely filed. The fee for submitting this Brief is \$330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. 16-1885 in the amount of \$330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885. Enclosed with this original are two copies of this brief.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on March 23, 2004 (Date of Transmission).
George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)

(Signature)

March 23, 2004 (Date)

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-17 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2003/0136203 A1 by Yoon ("Yoon '203") in view of U.S. Patent Application Publication No. US 2003/0072469 A1 by Alden ("Alden '469").

Claim 16 is further under final rejection of the Examiner rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly the subject matter which applicant regards as the invention.

Appellants hereby appeal the rejection of claims 1-17.

IV. Status of Amendments

An Amendment subsequent to the Final Rejection of October 23, 2003, was filed on January 23, 2004. This Amendment After Final was not entered because in the Examiner's opinion the Amendment to claim 1 would not place the case in condition for allowance as rejected claim 9 has similar limitations as those added.

Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

However, Applicants respectfully submit that the Amendment After Final should have been entered, particularly as the amendment to claim 16 directly addressed the outstanding rejection under 35 U.S.C. section 112, second paragraph and clearly puts the case in better condition for appeal. Furthermore, Applicants respectfully submit that

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the proposed amendments to claims 1 and 3 of the Amendment After Final would put the case in better condition for appeal.

V. Summary of Invention

Appellants' invention relates to methods and systems for providing a quarantine notification to the sender and/or intended recipient of a mail piece that is quarantined by a hazard detection system such as a mailbox detector. Figures 4 and 9 are reproduced below for use in a summary discussion of an illustrative embodiment. As can be appreciated from Figure 4, many untainted mail pieces may be quarantined in mailbox receptacle 200 if a hazard is detected. As shown below, scanner 211 may be used to scan an image of the face of a mail piece or to otherwise detect mail piece information.

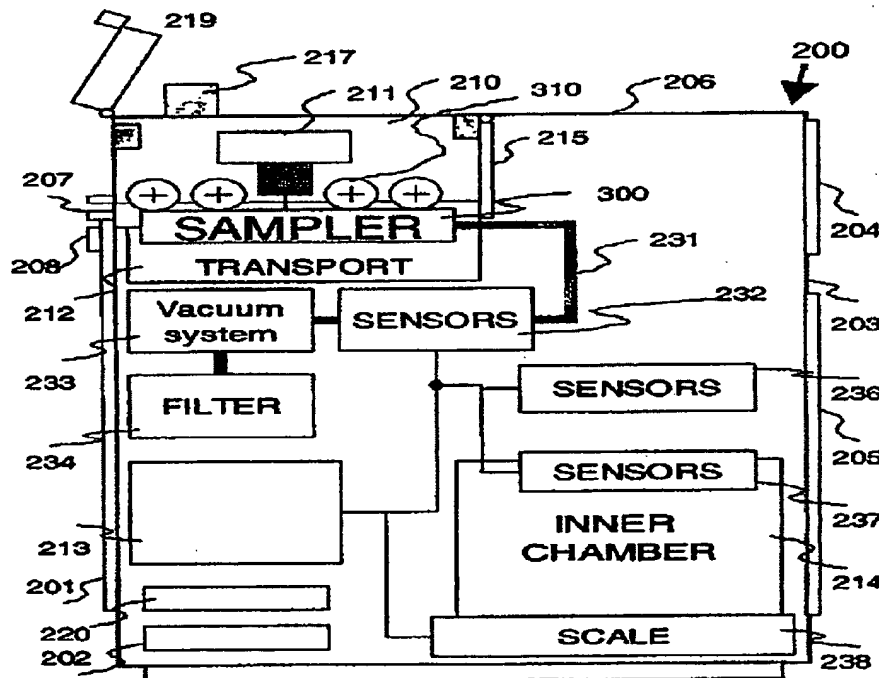


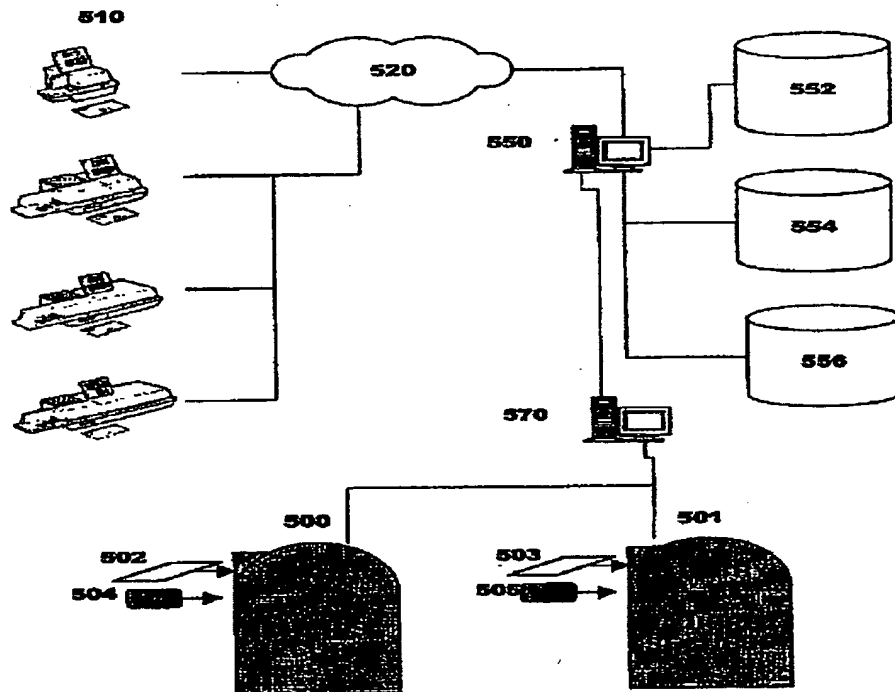
FIG. 4

As shown in Figure 9, reproduced below, Server 570 is connected to each incoming mail receptacle, 500, 501 using a communications channel. The incoming mail receptacle scans each incoming mail piece and stores the information. If a contamination hazard indication is received, the entire mailbox is physically

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quarantined. The mailbox 500 then uploads the current mail information to the server 550. The server determines source and destination information. For example, the server is programmed to perform an OCR of the scanned image of each envelope in the tainted mailbox to identify users or to decode a postage meter serial number as a user identifier. Database 556 includes notification information. The server will then utilize database 556 to attempt to locate a known valid email address for the sender and the recipient. If a known address is found, a notification email describing the facts of the quarantined mail including the mailbox location is sent. Other notification scenarios are described.



Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

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VI. Issues

Whether claims 1-17 are patentable under 35 U.S.C. §103(a).

Whether claim 16 is patentable under 35 U.S.C. §112, second paragraph.

VII. Grouping of Claims

Claims 1-17 are grouped in the following groups:

Group I – Claims 1-2 and 9.

Group II - Claim 3-8, 10-12 and 16-17.

Group IV – Claims 13 and 15.

Group V – Claim 14.

In Group I, independent claim 1 and claim 2 that depends directly from claim 1 and independent claim 9 stand or fall together.

In Group II, independent claim 3 and claims 4-8 and 16-17 that depend directly or indirectly from claim 3 and independent claim 10 and claims 11-12 that depend directly or indirectly from claim 10 stand or fall together.

In Group III, claim 13 that depends directly from claim 10 and claim 15 that depends directly from claim 3 stand or fall together.

In Group IV, claim 8 that depends directly from claim 10 stands or falls alone.

VIII. Argument

As Appellants discuss in detail below, the final rejection of several of claims 1-17 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The Yoon '203 and Alden '469 References are Not Properly Combined Under 35 U.S.C. Section 103(a)

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Initially, the Examiner relies on the filing date of a related provisional patent application in the Yoon '203 reference, yet does not provide a copy of the earlier reference to support entitlement to the earlier filing date for the material cited. Accordingly, the reference is not available as prior art.

Appellants argue that there is no motivation to combine the references. For the rejection to stand, there must be some teaching, suggestion or motivation to combine the references found in the references themselves or the general knowledge of one of skill in the art. *Citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1998) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). However, the Examiner proceeded to use the invention itself as the roadmap to justify combining the references by stating that

Since Alden and Yoon are both from the same field of endeavor of scanning and detecting the potentially hazardous mail, the purpose disclosed by Alden would have been well recognized in the pertinent field of Yoon.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the system of Yoon such that the system includes: an image scanner; a scan detection system; and a server connected to the plurality of hazard detectors, as taught by Alden, for the purpose of providing means for communicating the result of detection data to at least one of the sender and the recipient. (October 23, 2003 Final Office Action, pp. 5-6.)

Applicants respectfully submit that there is no motivation to combine the cited references as suggested by the Examiner. For example, the cited references do not even appreciate the problem of detecting user data and notifying remote users of a quarantine condition. Yoon '203 describes a local detector providing only local hazard indications and in no way describes or suggests a quarantine condition. Furthermore, Alden '469 does appreciate a problem of detecting hazards and providing quarantine notifications to remote users that unknowingly have mail pieces stuck in quarantine. Additionally, as discussed below, Alden '469 does not even describe detecting source information from the mail piece.

As the Federal Circuit has held, "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art ..."

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See *In re Fitch*, 972 F.2d 1260, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1998). The cited prior art does not provide even a hint of the problem of notifying remote users of a quarantine condition by detecting user data. The Examiner shows no reference or knowledge to support even an appreciation of a problem that would suggest such a combination of the references in a way that is nowhere suggested in the references. See also *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F. 3d 877 (Fed. Cir. 1998). Accordingly, the references are not properly combined and the rejection should be reversed.

B. Claims 1-2 and 9 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 1-2 and 9 are in the case and under final rejection of the Examiner and stand rejected under 35 U.S.C. § 103(a) as allegedly being rendered obvious by U.S. Patent Application Publication No. US 2003/0136203 A1 by Yoon ("Yoon '203") in view of U.S. Patent Application Publication No. US 2003/0072469 A1 by Alden ("Alden '469").

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. *In re Ochiai*, supra; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Dow Chemical Co.*, 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

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Claim 1 is directed to a system for detecting hazards in a mail piece and notifying users having quarantined mail using a scan detection system and is shown below:

1. A system of hazard detector systems for detecting hazards in a mail piece and notifying users including senders and recipients having quarantined mail comprising:

a plurality of detectors each including a contaminant detection hazard detector for triggering a mail piece quarantine indication, an image scanner for scanning the face of a mail piece, a communications system, and a scan detection system for providing sender and recipient information for quarantined mail pieces; and

a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient. (emphasis added).

In the October 23, 2003 Final Office Action, the Examiner rejected claims 1-2 and 9 under 35 U.S.C. section 103(a). Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

The Examiner cites to Yoon '203 and Alden '469 but ignores the elements relating to detecting sender and recipient information and determining a notification method. The Examiner states that:

Yoon discloses a system comprising:

a mailbox including a plurality of detectors (114) each including a contaminant detection hazard detector; and
a communication system between the detectors and a computer (137), the computer receiving scan detection data.

However, Yoon does not expressly disclose the system including:

an image scanner for scanning the face of a mail piece;

a scan detection system for providing sender and recipient information;

a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient.

Alden teaches, for an anti-terrorist network hardcopy mail scanning and remote viewing system and process, that the invention comprises:

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an image scanner for scanning the face of a mail piece (see Figs. 5-9);
a scan detection system for providing sender and recipient information (see Figs. 5-9 and the description thereof);
a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient (Id.). (10/23/03 Final Office Action, pp. 2-3).

Yet, the cited references do not even appreciate the problem of notifying remote users of a quarantine condition and certainly do not teach or fairly suggest the invention as presently claimed. Alden does not disclose determining sender and recipient information nor does it describe determining a notification method.

As discussed above, the references are not properly combined. Furthermore, even if the references were to be found to be properly combined, the references do not teach or fairly suggest the invention as presently claimed and in particular do not teach or suggest a scan detection system for providing sender and recipient information for quarantined mail pieces. Additionally, the references do not teach or fairly suggest determining a notification method and for communicating the notification to at least one of the sender and the recipient. Additionally, other claimed elements are not taught or suggested by the cited references.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

Independent claim 9 includes similar elements and is patentable over the cited references for at least the same reasons. The referenced dependent claims are patentable over the cited references for at least the reasons discussed above regarding the respective independent claims. For at least the above stated reasons, Appellants respectfully submit that the final rejection as to claims 1-2 and 9 is in error and should be reversed.

C. Claims 3-8, 10-12 and 16-17 are Not Unpatentable Under 35 U.S.C. section 103(a)

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Claim 3 is directed to a method for method for communicating a quarantine condition to mail system users by among other things detecting source information from the mail piece and is shown below:

3. A method for communicating a quarantine condition to users including senders and recipients of a mail system having a plurality of hazard detector systems with hazard detection systems connected to a central server comprising:

- detecting the presence of a mail piece;
- detecting source information from the mail piece;
- testing the mail piece for hazards to determine an initial mail piece quarantine condition;
- alerting the central server upon detection of a hazard and providing source information to the central server;
- determining a notification method; and
- notifying at least one user of the mail piece quarantine. (emphasis added).

The Examiner has not shown a reference or properly combined references teaching or suggesting at least the element emphasized above.

The Examiner cites to Yoon '203 and Alden '469 but ignores the elements relating to detecting sender and recipient information and determining a notification method. As discussed above, the references are not properly combined. Furthermore, even if the references were to be found to be properly combined, the references do not teach or fairly suggest the invention as presently claimed and in particular do not teach or suggest detecting source information from the mail piece and determining a notification method.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

Independent claim 10 includes similar elements and is patentable over the cited references for at least the same reasons. The referenced dependent claims are patentable over the cited references for at least the reasons discussed above regarding the respective independent claims. For at least the above stated reasons, Appellants

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respectfully submit that the final rejection as to claims 3-8, 10-12, and 16-17 is in error and should be reversed.

D. Claim 13 and 15 are Not Unpatentable Under 35 U.S.C. section 103(a)

Claim 13 depends directly from claim 10 and claim 15 depends directly from claim 3 and they are patentable for at least the reasons as described above with reference to claims 10 and 3, respectively.

Furthermore, claim 13 recites:

13. The method of claim 10 wherein the sender information includes detecting a meter number. (emphasis added).

The Examiner has not shown a reference or properly combined references teaching or suggesting at least the element emphasized above. For example, the meter number can be a key into a user database that facilitates notification.

Accordingly, the Examiner has failed to establish a prima facie case for an obviousness rejection.

For at least these reasons, Appellants respectfully submit that the final rejection as to claims 13 and 15 is in error and should be reversed.

E. Claims 14 is Not Unpatentable Under 35 U.S.C. section 103(a)

Claim 14 depends indirectly from claim 10. This claims is patentable for at least the reasons as described above with reference to claim 10. Additionally, they are patentable over the cited reference for the following reason.

Claim 14 recites:

14. The method of claim 10 further comprising:
storing a plurality of sender information records relating to a plurality of mail pieces placed in the at least one mailbox; and
if the initial mail piece quarantine condition is detected, notifying at least two users indicated by the plurality of sender information records. (emphasis added).

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The Examiner has not provided any reference or combination of references teaching or fairly suggesting a plurality of quarantined mail pieces and the notification of at least two users as shown in the element emphasized above.

For at least these reasons, Appellants respectfully submit that the final rejection as to claim 14 is in error and should be reversed.

F. Claim 16 is Not Unpatentable Under 35 U.S.C. section 112

Claim 16 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite for stating an element without antecedent basis. As discussed above, Applicants proposed an Amendment After Final in the form:

16. (currently amended) The method of claim 3 further comprising: wherein scanning the mail piece to obtain the recipient information comprises a scan.

The Amendment was not entered. Applicants submit that the Amendment After Final should have been entered, and that alternatively, the claim is sufficiently clear as to be definite.

For at least these reasons, Appellants respectfully submit that the final rejection as to claim 16 is in error and should be reversed.

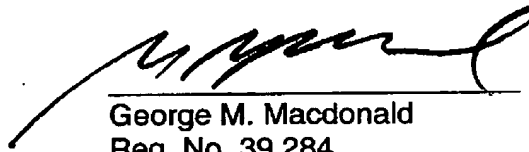
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IX. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-17 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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APPENDIX A

1. A system of hazard detector systems for detecting hazards in a mail piece and notifying users including senders and recipients having quarantined mail comprising:

a plurality of detectors each including a contaminant detection hazard detector for triggering a mail piece quarantine indication, an image scanner for scanning the face of a mail piece, a communications system, and a scan detection system for providing sender and recipient information for quarantined mail pieces; and

a server connected to the plurality of hazard detectors for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient.

2. The system of claim 1 further comprising:

a secure Internet connection between each hazard detector system and the server.

3. A method for communicating a quarantine condition to users including senders and recipients of a mail system having a plurality of hazard detector systems with hazard detection systems connected to a central server comprising:

detecting the presence of a mail piece;

detecting source information from the mail piece;

testing the mail piece for hazards to determine an initial mail piece quarantine condition;

alerting the central server upon detection of a hazard and providing source information to the central server;

determining a notification method; and

notifying at least one user of the mail piece quarantine.

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4. The method of claim 3 wherein the source detection includes detecting a destination address.

5. The method of claim 3 wherein the source detection includes detecting a return address.

6. The method of claim 3 wherein the determination of a notification method comprises determining if a valid email address is available for the user.

7. The method of claim 3 wherein the determination of a notification method comprises determining if a valid telephone number is available for the user.

8. The method of claim 3 wherein the determination of a notification method comprises determining if the mail piece address is a valid postal address for the user.

9. A mail receiving system for detecting hazards in a mail piece and notifying users including senders and recipients having quarantined mail comprising:

a plurality of mailboxes each including a contaminant detection hazard detector for triggering a mail piece quarantine indication, an image scanner for scanning the face of a mail piece, a communications system, and a scan detection system for providing source and recipient information for quarantined mail pieces; and

a server connected to the plurality of mailboxes for receiving scan detection data, determining a notification method and for communicating the notification to at least one of the sender and the recipient.

10. A method for communicating a quarantine condition to users including senders and recipients of a mail system having at least one mailbox including hazard detection systems connected to a central server comprising:

detecting the presence of a mail piece in the mailbox;

detecting sender information from the mail piece;

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testing the mail piece in the mailbox for hazards to determine an initial mail piece quarantine condition;
alerting the central server upon detection of a hazard and providing source information to the central server;
determining a notification method; and
notifying at least one user of the mail piece quarantine using the sender information.

11. The method of claim 10 wherein the sender information includes detecting a destination address.

12. The method of claim 10 wherein the sender information includes detecting a return address.

13. The method of claim 10 wherein the sender information includes detecting a meter number.

14. The method of claim 10 further comprising:
storing a plurality of sender information records relating to a plurality of mail pieces placed in the at least one mailbox; and
if the initial mail piece quarantine condition is detected, notifying at least two users indicated by the plurality of sender information records.

15. The method of claim 3 wherein the sender information comprises a meter number.

16. The method of claim 3 wherein the recipient information comprises a scan.

17. The method of claim 3 further comprising:
detecting destination information from the mail piece.